REMARKS / ARGUMENTS

1. *Dayco / McKesson* Disclosure

In accordance the undersigned's current understanding of the obligations imposed by *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003) and *McKesson Information Solutions, Inc. v. Bridge Medical, Inc.*, 487 F.3d 897 (Fed. Cir. 2007), the following co-pending application(s) whose file history may contain material information are identified. In assessing the patentability of the pending claims, the Office is respectfully requested to review the file history of each the listed co-pending application(s), determine whether such co-pending application has "similar subject matter" and, if so, consider each Office Action, including each reference on which a rejection is based, and each paper submitted by applicant therein.

a. Application serial no. 11/164,187, filed on November 14, 2005 and entitled *Integrated Heat Exchanges In A Rack For Vertical Board Style Computer Systems*, issued on May 6, 2008 as US 7,367,384.

b. Application serial no. 12/052,599, filed on March 20, 2008 and entitled *Integrated Heat Exchanges In A Rack For Vertical Board Style Computer Systems*, as a continuing application of serial no. 11/164,187. The status of this application is: TS review Complete. A preliminary amendment was filed on June 2, 2008.

c. Application serial no. 11/308,267 filed on March 14, 2006 and entitled *Method and Apparatus for Cooling Electronic Enclosures*, received non-final action on August 20, 2008.

d. Application serial no. 11/458,732 filed on July 20, 2006 and entitled *Electronic Equipment Cabinet with Integrated, High Capacity, Cooling System, and Backup Ventilation.* A response to a restriction requirement was filed on 12/19/2008.

e. Application serial no. 10/904,889, filed on December 2, 2004 and entitled *Cooling System for High Density Heat Load*, is currently pending before Examiner Emily I. Nalven. A request for continued examination was filed on 10/01/2008.

2. Petition to Correct Inventorship

Assignee notes that it filed on December 10, 2007 a Petition to Correct Inventorship pursuant to 35 U.S.C. § 116 and 37 C.F.R. § 1.48. No disposition of that Petition has been received.

Pursuant to MPEP § 1002.02(d), ¶5, such petition is to be acted upon by the Supervisory Examiner. Assignee notes that the Petition is not listed in the IFW for the subject application available on PAIR and, therefore, respectfully urges the Examiner to determine if the Petition is currently on the docket for Supervisory Examiner for this file, and, if not, to determine what needs be done to have the Petition taken up in a timely manner.

3. Response to July 16, 2008 Final Office Action

For the convenience of the Examiner and clarity of purpose, Assignee has reprinted the substance of the Final Office Action (not necessarily in order) in ***9-point bolded and italicized font.*** Assignee's arguments immediately follow in regular font.

> ***10. The Examiner has reviewed the applications cited in the Dayco/McKesson Disclosure and finds that each does have "similar subject matter", however the Examiner notes that the filing date of the present application antedates the filing dates of all the applications listed and therefore the subject matter is not relevant to the present invention.***

Assignee thanks the Examiner for considering these applications. Assignee would note, however, that the filing date of the subject application (03/02/2004) ***predates*** (not antedates) the priority filing dates of each of the pending applications.

> ***With respect to the Applicants' remarks to claim 26 that, "this amendment to claim 26 renders that claim patentable for at least the same reasons that the Examiner considers claim 31 patentable", the Examiner respectfully disagrees. The Examiner notes that by the Applicant's own admission, the limitations added to claim 26 are more broad than that which was recited in claim 31 (See Page 17 of the present remarks). The present limitations in claim 26 are sufficiently broad so as to not be allowable as per the rejection to claim 26 above.***

In an earnest effort to place this application in condition for allowance, and without acceding to the Office's arguments, Assignee has amended claim 26 as shown below:

> 26. (Currently amended) A system comprising:
> a chassis;
> an air mover coupled to the chassis to induce a flow of air along a flow path within the chassis;
> a first electronics compartment positioned in the chassis and in the air flow path;
> a first air-to-fluid heat exchanger positioned in the chassis and in the air flow path, wherein the first heat exchanger includes at least one internal fluid passage configured to carry a working fluid at least a portion of which undergoes a phase change within the at least one fluid passage to absorb[[s]] heat from the air flow path;
> a heat exchanger positioned external to and spaced apart from the chassis and in fluid communication with the first heat exchanger, wherein the external heat exchanger is configured to cool the working fluid; and
> a controller operably coupled to the system to control the pressure or temperature of the working fluid supplied to the first heat exchanger to facilitate the phase change within the first heat exchanger.

Assignee contends claim 26 is patentable over Miller and each of the other cited art, including the asserted combinations of cited art. As previously argued, Miller does not disclose or teach the invention of claim 26. For example, and without limitation, Miller teaches only the use of ***water*** as a working fluid. Claim 26, as amended above, requires that at least a portion of [the working fluid] undergoes a phase change within the at least one fluid passage." ***A chilled water system, such as Miller, does not remove heat by phase change, such as from a liquid to a gas***.

Further, Miller discloses no "controller." What the Office labels "controller (50)" is actually "pump (50)." See, e.g., 10:55-63. Miller has no disclosure or teaching of "a controller operably coupled to the system to control the pressure or temperature of the working fluid supplied to the first heat exchanger to facilitate the phase change within the first heat exchanger" as required by amended claim 26.

Assignee contends that no other cited reference discloses or teaches the system of claim 26 in which the system is controlled so that the working fluid is cooled in an external heat exchanger to a pressure or temperature that will cause the working fluid to change state within the first heat exchanger. Contrary to the Office's contention, James does not disclose or teach such control.

James discloses a vapor compression refrigeration system incorporating a non-powered cooling cycle in which heat from a higher temperature region is transferred to a region cooled by the vapor compression system. James teaches that the working fluid for the non-powered cycle is selected to "exhibit[] a phase change at the appropriate temperature for a particular application, i.e., air conditioning, refrigeration, or freezing." James relies on gravity to force the liquid and vapor working fluid to circulate. Thus, among other things, James does not disclose ***controlling*** the temperature or pressure of his working fluid.

Further, on the powered, vapor-compression cycle, James teaches the conventional use of an expansion valve or device to lower the pressure of the compressed liquid so that it vaporizes in the freezer compartment heat exchanger. See column 6. James does not teach the benefit of or structure for controlling "the pressure or temperature of the working fluid … to facilitate the phase change within the first heat exchanger."

For at least these reasons, Assignee submits that claim 26 is patentable over the cited art. Reconsideration and withdrawal of this rejection is earnestly requested.

Independent claims 1, 51, 57, 72 and their respective dependents are not patentable for at least the reasons indicated above in regards to claim 26.

Assignee has amended independent claims 1, 51, 57, 72, and 79 similarly to independent claim 26. With these amendments and for at least the reasons presented above, Assignee submits that claims 1, 51, 57, 72 and 79 are patentable over the cited art. Reconsideration and withdrawal of these rejections is earnestly requested.

Assignee does not accede to the Office's characterizations of the cited references and reserves its right to challenge such characterizations at a later time.

> ***Claim 80 is objected to since it depends from itself. For the purposes of examination, the claim has been considered to depend from claim 79. Additionally, claims 81-84 all depend from claim 80.***

The Examiner is correct that the dependency of claims 80 – 84 are incorrect. Each claim has been amended to depend from independent claim 79. Reconsideration is requested.

4. Other Amendments

In addition to the amendments discussed above in relation to the Office Action, Assignee has chosen to amend a variety of claims for reasons unrelated to any rejection or objection.

Claims 4 has been amended to conform it to amended claim 1.

Claim 31 has been canceled.

Assignee believe this is a complete listing of amendments made other than in response to the Office Action, but the actual claim amendments shall control any discrepancies.

6. Conclusion

After the amendments presented herein, a total of 50 claims are pending with 6 being of independent form. Claims 2, 3, 5, 6, 14–18, 20, 21, 25, 30, 31, 41, 44-50, 54, 55, 56 and 62–71 have been canceled without prejudice in this or a previous paper. Claim 35 is withdrawn, but is amended herein. Assignee submits that each claim presented herein is patentable over the art of record. A timely notice of allowance is respectfully requested.

Assignee thanks the Examiner for his consideration and effort on this file. If there are any questions or if additional information is needed, the Examiner is invited to telephone or email the undersigned.

Respectfully submitted,

LOCKE LIDDELL & SAPP LLP

By

Albert B. Deaver, Jr.
Reg. No. 34,318
Tel.: (713) 226-1141
adeaver@lockeliddell.com